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MAILED

JAN 27 2011

OFFICE OF PETITIONS

In re Application of :
Morgan et al. : DECISION GRANTING PETITION
Application No. 09/213,856 :
Filed: December 17, 1998 :
Atty Docket No.N0484.70331US00:

This is in response to the REQUEST FOR RECONSIDERATION OF DECISION ON PETITION, filed October 7, 2010.

By Notice of Abandonment mailed March 22, 2005, applicants were advised that the application was abandoned as a result of petitioner's failure to take appropriate action in a timely manner after the decision rendered on September 22, 2004, by the Board of Patent Appeals and Interferences (BPAI). Therefore, the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(c). As no claim was considered allowed, the application became abandoned.

By decision mailed August 11, 2010, the initial petition filed July 16, 2006 (and added to by petition filed January 12, 2009), and treated as a (no-fee) petition to withdraw the holding of abandonment was dismissed. On petition, applicant was persuasive that given the filing of a terminal disclaimer (on October 6, 2004) and allowable subject matter being found in another application (09/213,858), this application should not have been held abandoned but rather the examiner should have taken further action in this application. Applicant's arguments were further supported by the provisions of 37 CFR § 1.197(b)¹ and MPEP § 1214.06, paragraph II².

¹ (1) Proceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except:

(i) Where claims stand allowed in an application; or
(ii) Where the nature of the decision requires further action by the examiner.

However, as no terminal disclaimer filed October 6, 2004 (or thereabouts) was of record in this application, the petition had to be dismissed.

On instant renewed petition, applicant has submitted adequate proof of the timely filing of a proper terminal disclaimer. Specifically, the petition includes a copy of the terminal disclaimer as originally filed with a USPTO auto-reply facsimile transmission confirming receipt in the Office of the 6 page response on October 6, 2004.

It is noted that the terminal disclaimer submitted on petition is sufficient for purposes of withdrawing the holding of abandonment. This decision does not preclude the examiner from objecting to the terminal disclaimer and requiring execution of a replacement terminal disclaimer, if warranted, signed by an attorney currently of record in this application.

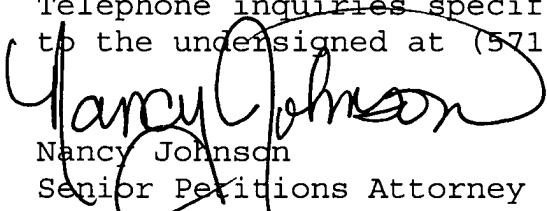
The holding of abandonment is hereby WITHDRAWN.

The petition under § 1.181 is GRANTED.

No fee is required on petition under § 1.181.

Technology Center AU 2654 has been advised of this decision. The application file is, thereby, forwarded to the Technology Center's technical support staff to withdraw the holding of abandonment and for consideration by the examiner of the terminal disclaimer shown to have been timely filed on October 6, 2004.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.


Nancy Johnson
Senior Petitions Attorney
Office of Petitions

² This MPEP section provides that:
when the time for seeking court review (plus 2 weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the examiner) has passed without such review being sought, the examiner must take up the application for consideration.